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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,323	10/28/2003	Louis P. Steinhauser	S269-000004/CPB	4859
28997	7590	11/09/2004	EXAMINER	
HARNESS, DICKEY, & PIERCE, P.L.C 7700 BONHOMME, STE 400 ST. LOUIS, MO 63105			BASINGER, SHERMAN D	
			ART UNIT	PAPER NUMBER
			3617	

DATE MAILED: 11/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/695,323	STEINHAUSER, LOUIS P. 	
	Examiner	Art Unit	3617
	Sherman D. Basinger		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-9 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
 5) Claim(s) ____ is/are allowed.
 6) Claim(s) 1-9 is/are rejected.
 7) Claim(s) ____ is/are objected to.
 8) Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 28 October 2003 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____.
 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____.
 5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____.

DETAILED ACTION

Oath/Declaration

1. The declaration filed under 37 C.F.R. 1.63 in response to the notice of a missing or unsigned declaration has been received.

Specification

2. The disclosure is objected to because of the following informalities: see below.

Appropriate correction is required.

In paragraph [0001] the patent number for 09/899722 should be inserted.

In paragraph [0022] "Figure 5" should be -Figure 6-.

In paragraph [0023] "Figure 6" should be -Figure 7-.

In paragraph [0024] "Figure 7" should be -Figure 8-.

A brief description of figure 5 which is accurate is required.

In paragraph [0037] "alarm 28" should be -alarm 38-.

In paragraph [0048] "Figure 6" should be -Figure 7-.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis.

Davis discloses an outboard motor position responsive system comprising an ignition system including the ignition switch sensor, an outboard motor position sensor 220 in communication with the ignition system, a microprocessor 100 in communication with the outboard motor position sensor, an alarm 380 in communication with the microprocessor and an ignition disabling switch shown at the bottom of figure 1b.

Davis does not disclose:

wherein when an

operator attempts to start the ignition system when the outboard motor is tilted up beyond a maximum safe tilt position, the alarm is activated by the microprocessor to warn the operator;

wherein when an

operator attempts to start the ignition system when the outboard motor is tilted up beyond a maximum safe tilt position, the ignition disabling switch is activated by the microprocessor to prevent the operator from starting the ignition system; and

wherein when

an operator attempts to start the ignition system when the outboard motor is tilted up beyond a maximum safe tilt position, the tilt circuit is

activated by the microprocessor to automatically lower the outboard motor.

However because the microprocessor of Davis can easily be programmed to all of the above, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to do so. Motivation to do so is to protect the outboard motor engine from damage and to protect the boat operator or a passenger from the outboard motor propeller.

Davis also does not disclose:

wherein when an operator attempts to start the ignition system when the outboard motor is tilted up beyond a maximum safe tilt position, the alarm is activated by the outboard motor position sensor to warn the operator; wherein when an operator attempts to start the ignition system when the outboard motor is tilted up beyond a maximum safe tilt position, the ignition disabling switch is activated by the outboard motor position sensor to prevent the operator from starting the ignition system; and wherein when an operator attempts to start the ignition system when the outboard motor is tilted up beyond a maximum safe tilt position, the tilt circuit is activated by the outboard motor position sensor to automatically lower the outboard motor.

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However, because the microprocessor of Davis can be programmed to have the outboard motor position sensor do all of the above, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to have it do so. Motivation, again, is to protect the outboard motor engine, the outboard motor propeller, the operator and any passenger.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claim 7 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6,682,371. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 3 of the patent includes every limitation of claim 7 and additionally adds the limitation of "wherein the communications are via infrared signals".

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In making the outboard motor position responsive system of claim 3 of the patent, one would make the outboard motor position responsive system of claim 7. Thus it would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to make the outboard motor position responsive system of claim 7 when making the outboard motor position responsive system of claim 3 of the patent. Motivation to do so is to make an outboard motor position responsive system which protects the engine of the outboard motor.

It is noted that claim 7 uses the word "start" as opposed to "engage" when referencing the ignition system. This is only a difference in verbiage and does not make claim 7 patentable over claim 3 of the patent.

7. Claim 8 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 8 of U.S. Patent No. 6,682,371. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 8 of the patent includes every limitation of claim 8 and additionally adds the limitation of "wherein the communications are via infrared signals". In making the outboard motor position responsive system of claim 8 of the patent, one would make the outboard motor position responsive system of claim 8. Thus it would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to make the outboard motor position responsive system of claim 8 when making the outboard motor position responsive system of claim 8 of the patent. Motivation to do so is to make an outboard motor position responsive system which protects the engine of the outboard motor.

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It is noted that claim 8 uses the words "start" and "starting" as opposed to "engage" and "engaging" when referencing the ignition system. This is only a difference in verbiage and does not make claim 8 patentable over claim 8 of the patent.

8. Claim 9 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 12 of U.S. Patent No. 6,682,371. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 12 of the patent includes every limitation of claim 9 and additionally adds the limitation of "wherein the communications are via infrared signals". In making the outboard motor position responsive system of claim 12 of the patent, one would make the outboard motor position responsive system of claim 9. Thus it would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to make the outboard motor position responsive system of claim 9 when making the outboard motor position responsive system of claim 12 of the patent. Motivation to do so is to make an outboard motor position responsive system which protects the engine of the outboard motor. It is noted that claim 9 uses the word "start" as opposed to "engage" when referencing the ignition system. This is only a difference in verbiage and does not make claim 9 patentable over claim 12 of the patent.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Schmiedel is cited to show the system for indicating to the boat

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drive the trim angle of the stern drive. Koike is cited to show the control unit 32 and the warning lights and buzzer.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sherman D. Basinger whose telephone number is 703-308-1139. The examiner can normally be reached on M-F (6:00-2:30 ET).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Samuel J. Morano can be reached on 703-308-0230. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Sherman D. Basinger
Primary Examiner
Art Unit 3617

sdb
11/3/04